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07/788,519	11/06/91	BLOUNT	G 4438U

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EXAMINER
HARRIS, S

ART UNIT PAPER NUMBER
3309

DATE MAILED: 09/21/92

This is a communication from the examiner in charge of your application.
COMMISSIONER OF PATENTS AND TRADEMARKS

☒ This application has been examined ☐ Responsive to communication filed on _____ ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input checked="" type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> _____ |

Part II SUMMARY OF ACTION

1. ☒ Claims 1-36 are pending in the application.

Of the above, claims _____ are withdrawn from consideration.

2. ☐ Claims _____ have been cancelled.

3. ☐ Claims _____ are allowed.

4. ☒ Claims 1-33 are rejected.

5. ☒ Claims 34-36 are objected to.

6. ☐ Claims _____ are subject to restriction or election requirement.

7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.

8. ☐ Formal drawings are required in response to this Office action.

9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are: ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).

10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).

11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).

12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.

13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. ☐ Other

EXAMINER'S ACTION

Claims 1-29 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant made reference to proximity relationship of components in the claimed invention as "the proximal end" and "the distal end" without properly defining or prior mentioning of such, hence improper antecedent referencing.

Claim 31 is rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim. The method claim 31 does not provide an additional step to the references claim 30, but merely alludes to the material in the eye to be aspirated.

The following is a quotation of the appropriate paragraphs of 35 U.S.C. § 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

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Claim 30 is rejected under 35 U.S.C. § 102(b) as being anticipated by Zelman. Zelman discloses a method as claimed for performing ophthalmic surgery via a probe comprising aspirating material and applying laser energy into the interior of an eye without replacing said probe.

Claims 1-3, 14, 15, 17, 18, 20 and 29 are rejected under 35 U.S.C. § 102(e) as being anticipated by Taboada et al. Taboada et al discloses a laser delivery device as claimed including a handpiece having a body and a hollow tip including a fluid path, a laser connector and an optical fiber included in the handpiece.

The following is a quotation of 35 U.S.C. § 103 which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Subject matter developed by another person, which qualifies as prior art only under subsection (f) or (g) of section 102 of this title, shall not preclude patentability under this section where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Claims 4, 6, 13, 21, 22 and 24 rejected under 35 U.S.C. § 103 as being unpatentable over Hasson in view of Reynolds et al. Hasson provides a disclosed laser structure having a

handpiece 20 with a fluid path 50 and a tip with a fluid path 62, an optical fiber contained in the handpiece 16, means for removably securing an intermediate portion of optical fiber 110 and a laser ^{44?}connector 46. Reynolds et al teaches a surgical device having a handpiece with a finger actuated refluxing means.

To have located the refluxing means of Hasson in the handpiece, in lieu of locating it in the proximal end, would have been an obvious modification, to one of ordinary skill in the art, in view of Reynolds et al to facilitate the control of the device.

Claim 13 is rejected under 35 U.S.C. § 103 as being unpatentable over Hasson in view of Taboada et al. Hasson discloses a structure providing all of the elements of the claimed device including a bore 64 extending from the cavity to the exterior of the handpiece and a suction source 60, with the exception of a tube for providing fluid communication between the bore and a suction source. *Note col 15 lines 66 →*

It would have been obvious to one of ordinary skill in the art to provide a tube, in lieu of a channel, for providing a path from the bore and the suction source as taught by Taboada et al at 91, in order to achieve localized suction.

Claims 32 and 33 rejected under 35 U.S.C. § 103 as being unpatentable over applicants' disclosure in view of Zelman. Zelman discloses all aspects of the method claims except it fails

to disclose the particular materials being aspirated in conjunction with repetition of the application of the laser energy without replacing the probe. Applicants' specification (note page 12) discloses that it is old to re-apply a suction probe as necessary to collect re-accumulated subretinal fluid between application of the laser probe.

To provide Zelman with additional steps of repetitious aspiration of particular ophthalmic materials between laser energy applications without probe replacement, as taught by applicants' prior art disclosure, would have been obvious to one of ordinary skill in the art for the reduction of instrument placement into the eye during surgery, hence reducing delay time and thereby simplifying the procedure.

Claims 34-36 are objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Claims 5-12, 19, 23 and 25-28 would be allowable if rewritten to overcome the rejection under 35 U.S.C. § 112 and to include all of the limitations of the base claim and any intervening claims.

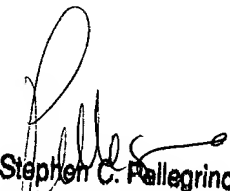
Any inquiry concerning this communication should be directed to Sonya C. Harris at telephone number (703) 308-0858.

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W S.C.H.
September 08, 1992


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Group 330